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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,914	07/11/2003	Toshiji Taiji	8017-1094	2404

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EXAMINER

UMEZ ERONINI, LYNETTE T

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,914

Applicant(s)

TAIJI ET AL.

Examiner

Lynette T. Umez-Eronini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/11/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On lines 2-5, "wherein a content ratio of said . . . diketone/benzotriazole-based compound . . . is not less 0.5 but not greater than 50" is indefinite because it is unclear by what is meant by "content". Does "content" refer to a specified weight, mass, etc.?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small et al. (US 6,313,039 B1) in view of Mahulikar (US 6,447,563 B1).

As to claims 1, 4, and 5, Small teaches a composition for chemical mechanical polishing that includes a slurry (Abstract) and that uses hydroxylamine nitrate (hydroxylamine nitrate, which is an oxidizing agent) in DI water (column 8, lines 4-7 and 24-29) at pH 4 (column 8, lines 25-29) and with adding alkyl beta-diketones (2,4 pentanedione, etc), (column 8, lines 36-46) in a CMP process (column 7, lines 39-40). Small also pointed out, "CMP of the copper metal can be done over a wide pH range (2 to 12). . . . In acid solutions an inhibitor, i.e. benzotriazole (BTA) is usually needed to control the isotropic etching effects from the chemistries used in the CMP process (column 3, lines 58-64).

Small differs in failing to teach a silica polishing material, **in claims 1 and 5**.

Mahulikar teaches, typically fumed silica is the most common abrasive used in manufacturing semiconductor and preferred abrasive is fumed silica or a solution grown form of silica (colloidal silica), (column 3, lines 48-50 and 55-57). The reference of Mahulikar is cited to illustrate that silica is a conventionally known polishing material added to CMP composition.

Since Small does not limit the use of particular abrasives, then, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention

to employ any known abrasive including a silica polishing material as the abrasive in the Small reference Mahulikar illustrates that silica is known to be effective an effective abrasive for CMP compositions.

Small differs in failing to specify a content ratio of said diketone to said benzotriazole-based compound (diketone/benzotriazole-based compound) is not less than 0.05 but not greater than 50, **in claim 3**; and said diketone is at least one type of a compound selected from the group consisting of 1,2-diketones; 1,3-diketones and 1,4-diketones, **in claim 4**.

However, Small illustrates the specific combination of a benzotriazole and diketone is known. As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select any content of benzotriazole and diketone as well as selected any diketone, including applicants' specifically claimed diketones that would effectively accomplish the disclosed composition because it has been held that there is no invention where the difference in proportions is not critical and was ascertained by routine experimentation because the determination of workable ranges is not considered inventive. See *In re Swain and Adams*, 70 USPQ 412 (CPA 1946).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynette T. Umez-Eronini whose telephone number is 571-272-1470. The examiner is normally unavailable on the First Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 25, 2005

NADINE G. NORTON
SUPERVISORY PATENT EXAMINER

